

EL 852430563US

FORM PTO-1390)
(REV. 11-2000)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

ATTORNEY'S DOCKET NUMBER
SHIM014**TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371**

U.S. APPLICATION NO. (If known, see 37 CFR 1.5)

10/019,335INTERNATIONAL APPLICATION NO.
PCT/JP00/04517INTERNATIONAL FILING DATE
JULY 6, 2000PRIORITY DATE CLAIMED
JULY 8, 1999

TITLE OF INVENTION

METHOD FOR CONSTRUCTING FULL-LENGTH CDNA LIBRARIES

APPLICANT(S) FOR DO/EO/US

OTA, Toshio, WAKAMATSU, Ai, ISOGAI, Takao, OTSUKA, Kaoru, SUZUKI, Yutaka, SUGANO, Sumio

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.
4. ☐ The US has been elected by the expiration of 19 months from the priority date (Article 31).
5. ☐ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
 - a. ☐ is transmitted hereto (required only if not communicated by the International Bureau).
 - b. ☐ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office(RO/US)
6. ☐ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☐ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☐ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
10. ☐ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11 to 20 below concern document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A **FIRST** preliminary amendment.
14. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
15. ☐ A substitute specification.
16. ☐ A change of power of attorney and/or address letter.
17. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 35 U.S.C. 1.821-1.825.
18. ☐ A second copy of the published international application under 35 U.S.C. 154(d)(4).
19. ☐ A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
20. ☒ Other items or information: **Copy of Notice of Defective Response, Communication; Copy of original Order Letter from client; Return Postcard**

U.S. APPLICATION NO. (If known, see 37 CFR 1.51)
10/019,335

INTERNATIONAL APPLICATION NO.
PCT/JP00/04517

ATTORNEY'S DOCKET NUMBER
SHIM014

21. ☒ The following fees are submitted:

Basic National Fee (37 CFR 1.492(a) (1)-(5)):

Neither international preliminary examination fee (37 CFR 1.482)
nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO
and International Search Report not prepared by the EPO or JPO.....\$1000.00

International preliminary examination fee (37 CFR 1.482) not paid to
USPTO but International Search Report prepared by the EPO or JPO.....\$860.00

International preliminary examination fee (37 CFR 1.482) not paid to USPTO
but international search fee (37 CFR 1.445(a)(2)) paid to USPTO.....\$710.00

International preliminary examination fee (37 CFR 1.482) paid to USPTO
but all claims did not satisfy provisions of PCT Article 33(1)-(4).....\$690.00

International preliminary examination fee (37 CFR 1.482) paid to USPTO
and all claims satisfied provisions of PCT Article 33(1)-(4).....\$100.00

ENTER APPROPRIATE BASIC FEE AMOUNT =

CALCULATIONS PTO USE ONLY

\$ 0.00

Surcharge of \$130.00 for furnishing the oath or declaration later than ☐ 20 ☒ 30
months from the earliest claimed priority date (37 CFR 1.492(e)).

\$130.00

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	\$
Total Claims	7- 20 =		x \$18.00	\$0.00
Independent Claims	1- 3 =		x \$80.00	\$0.00
MULTIPLE DEPENDENT CLAIMS(S) (if applicable)			+ \$270.00	\$0.00

TOTAL OF ABOVE CALCULATIONS =

\$

☐ Request for Extension of Time for Two (2) Months from May 19, 2002 to July 19, 2002

\$0.00

SUBTOTAL =

\$130.00

Processing fee of \$130.00 for furnishing the oath or declaration later than ☐ 20 ☐ 30
months from the earliest claimed priority date (37 CFR 1.492(f)).

\$

TOTAL NATIONAL FEE =

\$ 0.00

Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be
accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property +

\$

TOTAL FEES =

\$130.00

7/20/2002 SHAJARRO 00000002 500815 10019335

FC:154 130.00 CH

Amount to be
refunded:

>

charged: \$130.00

a. ☐ A check in the amount of \$_____ to cover the fees is enclosed.

b. ☒ Please charge my Deposit Account No. 50-0815 in the amount of \$130.00 to cover the above fees.
A duplicate copy of this sheet is enclosed.

c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any
overpayment to Deposit Account No. 50-0815. A duplicate copy of this sheet is enclosed.

d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. **Credit card**
information should not be included on this form. Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed
and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

KARL BOZICEVIC (28,807)

DATE: 15/AUG/02



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
 United States Patent and Trademark Office
 Washington, D.C. 20231
 www.uspto.gov

U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/019,335	Toshio Ota	SHIM014

Karl Bozicevic
 Bozicevic Field & Francis
 200 Middlefield Road
 Suite 200
 Menlo Park, CA 94025

INTERNATIONAL APPLICATION NO.	
PCT/JP00/04517	
I.A. FILING DATE	PRIORITY DATE
07/06/2000	07/08/1999

CONFIRMATION NO. 1341
371 FORMALITIES LETTER



OC000000008530946

Date Mailed: 07/29/2002

NOTIFICATION OF DEFECTIVE RESPONSE

The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as an Elected Office (37 CFR 1.495):

- U.S. Basic National Fee
- Priority Document
- Biochemical Sequence Diskette
- Biochemical Sequence Listing
- Copy of IPE Report
- Copy of references cited in ISR
- Copy of the International Application
- Copy of the International Search Report
- Oath or Declaration
- Request for Immediate Examination

18/10/02
DOCKETED
MP (3 mos. ext) 12/12/02
LD 10/19/02
defective oath

The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:
 - 4TH INVENTOR NAME SPELLED DIFFERENT. PUB.LISH SPELLING SAITO, KAORU, ON DEC. THE NAME SPELLED OTSUKA KA0UR.
- \$130 Surcharge for providing the oath or declaration later than the appropriate 30 months months from the priority date (37 CFR 1.492(e)) is required.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements, whichever is the longer. Extension of this time limit may be granted under 37 CFR 1.136, but the period for response set in the Notification of Missing Requirements may be extended under 37 CFR 1.136(a).

SUMMARY OF FEES DUE:

Total additional fees required for this application is \$130 for a Large Entity:

- \$130 Late oath or declaration Surcharge.

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

*A copy of this notice **MUST** be returned with the response.*

VONDA M WALLACE

Telephone: (703) 305-3736

PART 1 - ATTORNEY/APPLICANT COPY

U.S. APPLICATION NUMBER NO.	INTERNATIONAL APPLICATION NO.	ATTY. DOCKET NO.
10/019,335	PCT/JP00/04517	SHIM014

FORM PCT/DO/EO/916 (371 Formalities Notice)

PTO/PCT Rec'd 15 AUG 2002

#6

SHIMIZU PATENT OFFICE

HATSUSHI SHIMIZU

KAZUNORI HASHIMOTO

SUGURU OSAKABE

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E-mail: shimpo@biopat.gr.jp

December 27, 2001

Confirmation by FedEx

Mr. Karl Bozicevic
BOZICEVIC FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200,
Menlo Park, CA 94025

CONFIRMATION
COPY COPY

Re: New U.S. Patent Application
Based on PCT Application No. PCT/JP00/04517; Filed July 6, 2000
Applicant: HELIX RESEARCH INSTITUTE
Our Ref.: H1-102PCT-US

Dear Karl:

Please enter the national phase of the above-identified International (PCT) Application in your country [US] on or before the 30M deadline of **January 8, 2002** in accordance with the following information.

[International Application]

International Filing Date: July 6, 2000

Application No.: PCT/JP00/04517

Title: "METHOD FOR CONSTRUCTING FULL-LENGTH cDNA LIBRARIES"

Priority: July 8, 1999 11/195104 JP

Applicant: HELIX RESEARCH INSTITUTE
1532-3, YANA, KISARAZU-SHI, CHIBA 292-0812 JAPAN
(Japanese Corporation)

Entity Status: Large Entity

SHIMIZU PATENT OFFICE

Mr. Karl Bozicevic
December 27, 2001
Page 2

Inventors: OTA, Toshio (Nationality: Japan)
c/o Kyowa Hakko Kogyo Co., Ltd., Tokyo Research Laboratories,
3-6-6, Asahi-machi, Machida-shi, TOKYO 194-8533 JAPAN
(New Address)

WAKAMATSU, Ai (Nationality: Japan)
1473-4-202, Takayanagi, Kisarazu-shi, CHIBA 292-0014 JAPAN

ISOGAI, Takao (Nationality: Japan)
511-12, Omuro, Ami-machi, Inashiki-gun, IBARAKI 300-0303 JAPAN

OTSUKA, Kaoru (Nationality: Japan)
2-8-6-A101, Maehara, Honjou-shi, SAITAMA 367-0047 JAPAN
(New Address)(*See Remarks)

Suzuki, Yutaka (Nationality: Japan)
2-7-23, Shirokane, Minato-ku, TOKYO 108-0072 JAPAN

SUGANO, Sumio (Nationality: Japan)
4-8-13, Minamiogikubo, Suginami-ku, TOKYO 167-0052 JAPAN

[National Phase]

Filing Due Date: **January 8, 2002 (30M)**

Enclosures:

1. Copy of International Publication
2. Translation of the filed International Application documents as follows:
 - 1) Translation of Description
 - 2) Translation of Claims
 - 3) Translation of Abstract
 - 4) Translation of Drawings
3. Copy of Request for the International Application and the copies which we have received from the Receiving Office (Japan)
4. Copies of all papers which we have received from the International Bureau
5. Copy of the International Search Report
6. Copy of Written Opinion
7. Copy of the demand for international preliminary examination
8. Copy of the international preliminary examination report
9. The Floppy Disk containing translation of description, claims, abstract (Microsoft Word 2000) and sequence listing (Text file). The Floppy Disk also contains this order letter(*)

* Please use the recorded information according to your needs.
(ex. request form, signature documents etc.)

SHIMIZU PATENT OFFICE

Mr. Karl Bozicevic
December 27, 2001
Page 3

[Remarks]

*The name of the fourth inventor has been changed from "SAITO, Kaoru" to "OTSUKA, Kaoru" due to marriage.

The application contains 29 pages of Description, 2 pages of Claims, 1 page of Abstract, 10 sheets of Drawings and 4 pages of Sequence Listing.

Please note that no amendments under Art. 19 or 34 PCT were filed.

We would like you to send us a Combined Declaration and Power of Attorney and an Assignment for the application to the e-mail address as follows as soon as possible:
kyoko@biopat.gr.jp

Please prepare and submit an appropriate Sequence Listing if necessary in accordance with the patent practice in your country.

Please send us a draft of the formal drawings before you file them with the USPTO.

If you recommend amendments, please send us a draft preliminary amendment before it is filed with the Patent Office.

Please confirm filing of the application by facsimile.

Please acknowledge your safe receipt of this letter by return facsimile and provide us with a copy of the document as filed, official papers, and your debit note. If you have any questions regarding this application, or if you require any additional documents or information, please feel free to contact us.

In the absence of our instructions, please keep this case in force.

Very truly yours,



Hatsushi Shimizu, Ph. D.

cc: Dr. Kenji Nagahari, Helix Research Institute

EXPRESS MAIL LABEL NO. EL 852 430 563

COMMUNICATION REGARDING DEFECTIVE RESPONSE Address to: Box AF Assistant Commissioner for Patents Washington, D.C. 20231	Attorney Docket Confirmation No.	SHIM-014 1341
	First Named Inventor	MIYATA, TOSHIO
	Application Number	10/019,335
	Intl. Filing Date	July 6, 2000
	Group Art Unit	To Be Assigned
	Examiner Name	To Be Assigned
	Title	METHOD FOR CONSTRUCTING FULL- LENGTH CDNA LIBRARIES

Sir:

This Communication is in response to the Notice of Defective Response dated July 29, 2002 (copy enclosed) for which a one month period for response was given for paying the required fees making the response due on or before **August 29, 2002**.

As stated in the Notice, the fourth inventor name is spelled different. The published spelling is "SAITO, KAORU" and on the executed Declaration filed June 27, 2002 the name appears "OTSUKA, KAORU." The name change of the fourth inventor is due to marriage as stated in the original order letter on pages 2 and 3 (see attached).

The Commissioner is hereby authorized to charge the Surcharge Fee of \$130.00, any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number SHIM-014.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date:

15/Aug/02

By:

Karl Bozicevic
Registration No. 28,807

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